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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,908	03/12/2004	Robert H. Dahlia	CB-12	8300
21394	7590	08/14/2007	EXAMINER	
ARTHROCARE CORPORATION 680 VAQUEROS AVENUE SUNNYVALE, CA 94085-3523			WITCZAK, CATHERINE	
ART UNIT		PAPER NUMBER		
		3767		
NOTIFICATION DATE		DELIVERY MODE		
08/14/2007		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[intel\\_prop@arthrocare.com](mailto:intel_prop@arthrocare.com)

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/799,908	DAHLA ET AL.
	<b>Examiner</b> Benjamin Huh	<b>Art Unit</b> 3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 June 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/22/07 & 5/31/07.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/31/07 has been entered.

### ***Claim Rejections - 35 USC § 102***

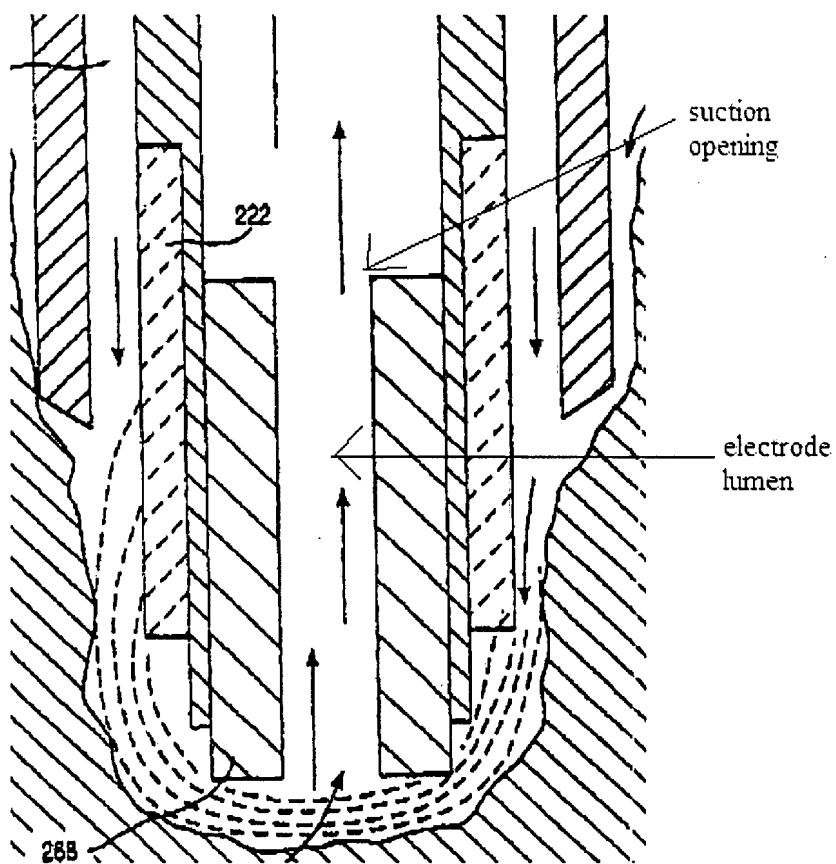
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggers et al (US Patent No. 5697882) or (US Patent No. 5871469) or (US Patent No. 5683366). The Eggers reference discloses an electrosurgical probe and method for treating a target tissue at a surgical site in figure 20 comprising a shaft and an electrode

assembly disposed on the shaft, wherein the electrode assembly includes an electrically insulating electrode support and at least one active electrode terminal arranged on the electrode support, each of the at least one active electrode terminal having an electrode lumen therethrough, wherein the electrode lumen is adapted for removing unwanted materials from the surgical site; and the at least one active electrode terminal comprises an end having an open electrode port in communication with the electrode lumen; and the at least one active electrode terminal comprises a body having a suction opening formed therein, the suction opening in communication with the electrode lumen, see attached figure below which comes from figure 20 and see col. 8 lines 8-53, col. 11 line 39 – col. 12 line 52, and col. 24 lines 8-31.



With respect to claims 2-14 & 17-19, for all 3 references see figure 20.

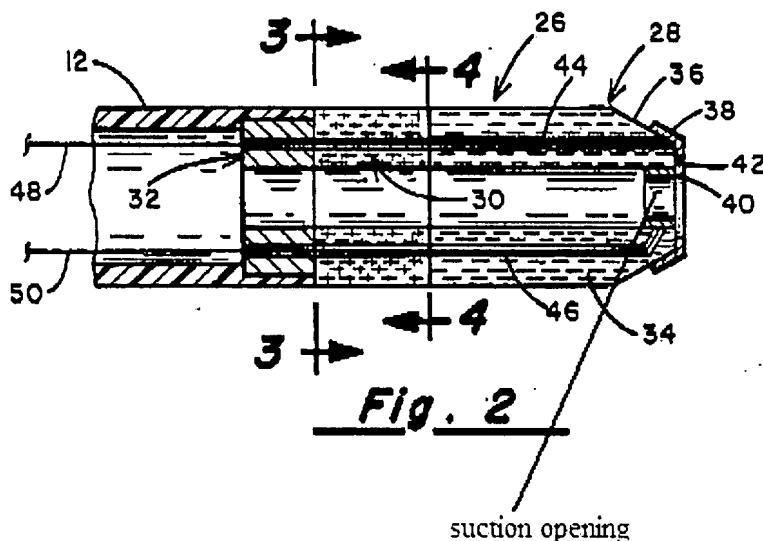
With respect to claims 15-16, see col. 11 line 39 – col. 12 line 52.

With respect to claim 20, see col. 3 line 47 – col. 4 line 47.

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1, 3-11, 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Stasz (US Patent No. 4936281). The Stasz reference discloses an electrosurgical probe and method for treating a target tissue at a surgical site in figure 2 comprising a shaft and an electrode assembly disposed on the shaft wherein the electrode assembly includes an electrically insulating electrode support 34 and at least one active electrode terminal 38 having a lumen therethrough and wherein the electrode lumen is adapted for removing unwanted materials from the surgical site, and the at least one active electrode terminal comprises an end having an open electrode port in communication with the electrode lumen; and the at least one active electrode terminal comprises a body having a suction opening formed therein, the suction opening in communication with the electrode lumen; also see col. 3 line 17 – col. 4 line 15, and col. 6 lines 31-45.



***Response to Arguments***

Applicant argues that Eggers does not disclose forming an additional opening in the body of the electrode as recited, the examiner disagrees. The claim only requires an opening and whereas as denoted in the rejections above there is an opening for the suction opening and a lumen for the electrode. The term opening is not defined in the specification and therefore the broadest reasonable definition can be utilized in determining what a suction opening can be.

Applicant argues that Stasz does not teach an additional opening, the examiner disagrees. In view of the arguments made above and due to the drawings added to the rejection, the examiner would like to note that there is an suction opening and an electrode lumen.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cohen (US Patent No. 4832048) discloses an electrosurgical probe with a shaft, electrode assembly, an open electrode port, and a body having a suction opening.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Huh whose telephone number is 571-272-8208. The examiner can normally be reached on M-F: 9:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BHH

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*